

## **REMARKS**

The above amendments and these remarks are responsive to the Office action dated March 29, 2004. Claims 1-39 are pending in the application. In the Office action, claims 31-39 are rejected under 35 U.S.C. 112 as being indefinite; claims 1-4, 6-8, 16-19, 26, 27, 29-31, 36, 38, and 39 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 2,999,253 to Lewis ("Lewis"); claims 5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis; and claims 9-15, 20-25, 32-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of U.S. Patent No. 4,138,753 to Wood ("Wood").

In view of the amendments above, and the remarks below, applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### **Rejections under 35 USC § 112**

Claim 31 has been amended to correct antecedent basis. Claim 31 as amended meets the requirements of 35 U.S.C. § 112. Furthermore, claims 32-39 are dependent from claim 31, and therefore also comply with the requirements of § 112.

### **Rejections under 35 USC § 102**

Claims 1-4, 6-8, 16-19, 26, 27, 29-31, 36, 38, and 39 are rejected under 35 U.S.C. § 102(b) as anticipated by Lewis. Applicants respectfully traverse these rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Lewis does not anticipate these claims because Lewis does not disclose each and every element of the claims.

Claim 1 recites a self-propelled personal watercraft having a body including a hull and a deck substantially covering the hull, wherein the body includes a bow portion and a stern portion, and a deck modification module removably attached to the deck, wherein the deck modification module is configured to be selectively removable to change a performance characteristic of the deck when the deck is submerged in water.

In contrast, Lewis discloses a convertible canoe and kayak having moveable cushions that can act either as a deck or as floor cushions. Parts 26 and 30 of Lewis, which are indicated in the Office action to be “deck modification modules,” are actually cushions (col. 2, ll. 58-66) that can be raised (col. 3, ll. 43-46) to act as a deck when the boat is configured as a kayak (col. 3, ll. 74-75), or lowered to act as a floor cushion when the boat is configured as a canoe (col. 4, ll. 5-11). When in the lowered position, the watercraft of Lewis has no deck at all. When in the raised position, the cushions are not attached to the deck, but instead *are the deck*. Lewis does not disclose any sort of module for attaching to this deck-of-cushions to change a performance characteristic of the deck when the deck is submerged in water, as recited in claim 1. For at least this reason, claim 1 is not anticipated by Lewis. Furthermore, claims 2-4 and 6-8 depend from and include all of the elements of claim 1, and therefore are also not anticipated by Lewis.

Next, claim 16 recites a self-propelled personal watercraft having a body including a hull and a deck at least partially covering the hull, and a buoyant deck modification module removably coupled to the deck, wherein the deck modification

module is removable to decrease a volume of water displaced by the deck when the deck is submerged in water.

In contrast, Lewis does not disclose a personal watercraft having all of the elements of claim 16. As discussed above, Lewis discloses a convertible canoe and kayak having cushions that can be raised from the floor of the craft to form a deck, but does not disclose a buoyant deck modification module removably coupled to this deck. Therefore, claim 16 is not anticipated by Lewis, and is in condition for allowance. Furthermore, claims 17-19, 26, 27 and 29-30 depend from and include all the elements of claim 16, and are thus also in condition for allowance.

Next, amended claim 31 recites a buoyant module for attaching to a deck of a decked self-propelled personal watercraft, having a first surface configured to rest at least partially against the deck of the personal watercraft, a second surface configured to interact with a flow of water across the deck of the personal watercraft, and a buoyant material disposed between the first surface and second surface.

In contrast, Lewis does not disclose a module for attaching to a deck of a decked self-propelled watercraft. Instead, Lewis discloses a watercraft with cushions that can be lifted to form a deck. No module for attaching to this deck is disclosed. For at least this reason, claim 31 is not anticipated by Lewis and is in condition for allowance. Furthermore, claims 36, 38, and 39 depend from claim 1 and include all the elements of claim 1, and are thus also in condition for allowance.

**Rejections under 35 USC § 103**

Applicants respectfully traverse the rejections of Claims 5 and 28 under 35 U.S.C. 103(a) as being unpatentable over Lewis, and the rejections of claims 9-15, 20-

25, 32-35, and 37 under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Wood.

To establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1988).

Claim 5 depends from claim 1, and includes all of the elements of claim 1. As discussed above in reference to claim 1, Lewis does not teach the element of a deck modification module removably attached to the deck, wherein the deck modification module is configured to be selectively removable to change a performance characteristic of the deck when the deck is submerged in water. Therefore, this element of claim 5 is not taught by Lewis.

Lewis also does not suggest such a deck modification module. This is at least because Lewis contains no teaching or suggestion that its watercraft can be used for tricks involving submerging the deck of the watercraft in water. If the bow or stern of Lewis were submerged in water while the cushions were in the "canoe" position, the Lewis watercraft would fill with water. Therefore, Lewis actually teaches away from submerging the watercraft bow when the cushions are in the "canoe" position. In fact, the teaching for the desirability of a deck modification module of claim 5 is found only in Applicants' disclosure, and not in the cited art. Therefore, any attempt to show a *prima facie* case of obviousness of claim 5 over Lewis impermissibly derives the suggestion for the combination of claim elements from Applicants' disclosure. Therefore, for at

least these reasons, Lewis does not teach or suggest all of the elements of claim 5, and claim 5 is not obvious over Lewis.

Applicants' also respectfully traverse the rejection of claim 28 as obvious over Lewis. Claim 28 depends from claim 16, and includes all of the elements of claim 16. As discussed above in reference to claim 16, Lewis does not disclose a buoyant deck modification module removably coupled to the deck, wherein the deck modification module is removable to decrease a volume of water displaced by the deck when the deck is submerged in water. Furthermore, as discussed above for claim 5, Lewis also does not suggest a buoyant deck modification module. Therefore, for at least these reasons, Lewis does not teach or suggest all of the elements of claim 28, and claim 28 is in condition for allowance.

Applicants also respectfully traverse the rejections of claims 9-15, 20-25, 32-35, and 37 as obvious over Lewis in view of Wood. This is because no combination of Lewis and Wood teaches or suggests all of the elements of these claims.

Claims 9-15 depend from and include all of the elements of claim 1. As discussed above in the context of claim 1, Lewis neither discloses nor suggests a deck modification module removably attached to the deck, wherein the deck modification module is configured to be selectively removable to change a performance characteristic of the deck when the deck is submerged in water. Wood also does not disclose the deck modification module of claim 1, and therefore of claims 9-15. Instead, Wood discloses an aquatic mat which is capable of floating on water and supporting one or more persons. Col. 1, ll. 27-30. The aquatic mat of Wood is not disclosed as being configured to be coupled to a deck of a decked watercraft. Therefore, no

combination of Lewis and Wood discloses or suggests all of the limitations of claims 9-15. For at least this reason, claims 9-15 are not obvious over Lewis in view of Wood, and are in condition for allowance.

Claims 20-25 depend from and include all of the elements of claim 16. As discussed above in the context of claim 16, Lewis neither discloses nor suggests a buoyant deck modification module removably coupled to the deck, wherein the deck modification module is removable to decrease a volume of water displaced by the deck when the deck is submerged in water. Wood also does not disclose the deck modification module of claim 16, and therefore of claims 20-25. Instead, Wood discloses an aquatic mat which is capable of floating on water and supporting one or more persons. Col. 1, ll. 27-30. The aquatic mat of Wood is not disclosed as being configured to be coupled to a deck of a decked watercraft. Furthermore, neither Wood nor Lewis suggests attaching the mat of Wood to the deck of the Lewis watercraft. Therefore, no combination of Lewis and Wood discloses or suggests all of the limitations of claims 20-25. For at least this reason, claims 20-25 are not obvious over Lewis in view of Wood, and are in condition for allowance.

Claims 32-35, and 37 depend from and include all of the elements of claim 31. As discussed above in the context of claim 31, Lewis neither discloses nor suggests a module for attaching to a deck of a decked self-propelled watercraft. Furthermore, Wood also does not disclose a module for attaching to a deck of a decked self-propelled watercraft. As discussed above, the aquatic mat of Wood is not disclosed as being configured to be coupled to a deck of a decked watercraft, and neither Lewis nor Wood suggests the combination of the convertible kayak and canoe with the aquatic mat. For

at least this reason, no combination of Lewis and Wood discloses or suggests all of the elements of claims 32-35 and 37, and these claims are therefore in condition for allowance.

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

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